

REMARKS/ARGUMENTS

Responsive to the Official Action dated August 30, 2006, requiring the election of a single group from Groups I-III as delineated on pages 2-3 of the Office Action, Applicants elect with traverse Group III. In addition, Applicants elect, also with traverse, the ultimate single species shown in Example 396, on page 631 of the specification for the purpose of searching the elected invention.

Restriction is only proper if the claims of the restricted groups are either independent or patentably distinct. The burden of proof is on the Office to provide reasons and/or examples to support any conclusions with regard to patentable distinctness, M.P.E.P. § 803.

Applicants respectfully traverse the Restriction Requirement on the grounds that no adequate reasons and/or examples have been provided to support patentable distinctness. Accordingly, the Office has failed to meet the burden necessary in order to sustain the Restriction Requirement.

All of the claims are integrally linked with each other. Compounds and the method of making and use of said compounds should be examined together. There is a commonality that exists among all of the Groups (I-III), and it is this technical relationship that involves the same features, and defines the contribution which each group taken as a whole makes over the prior art.

The Examiner has not considered that the claims in each group are considered related invention under 37 C.F.R. § 1.475(b) in which the inventions are considered to have unity of invention. Applicants submit that while PCT Rule 13.1 and 13.2 are applicable 37 C.F.R. § 1.475(b) provides in relevant part that “a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn to ... (3) a product, process specially adapted for the manufacture of said product, and the use of said product.” In the present application the composition, method of making

and use thereof meet the unity of invention requirement. Accordingly, the restriction is believed to be improper.

Applicants respectfully traverse the Election of Species requirement on the grounds that the Office has not provided sufficient reasons to support conclusions of patentable distinctness. Rather the Office has stated conclusions.

In chemical cases a specified group of materials which do not necessarily belong to an otherwise class can be claimed together employing "Markush" practice. The Markush practice sanctions the claiming together operable substances which could not be defined by generic language but which nevertheless have a community of chemical or physical characteristics. The members of the grouping need only possess at least one property in common which is responsible for their function in the claimed relationship. In the instant application the common characteristic is the ability of the species to inhibit the activity against the production or secretion of β -amyloid proteins, and medicaments to treat for various diseases associated by abnormal production or secretion of β -amyloid proteins. The same function in a generic sense suffices.

Moreover, Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office. As the Office has not shown any evidence that a restriction requirement should be required when the International Preliminary Examination Report did not, restriction is believed to be improper.

Applicants make no statement regarding the patentable distinctness of the species, but notes that for the restriction to be proper there must be patentable differences between the species as claimed. M.P.E.P. § 808.01(a).

For the reasons set forth above, Applicants request that the Restriction Requirement be withdrawn.

Finally, Applicants submit that, should the elected invention be found allowable, the Office should expand its search to the non-elected groups.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and an early notice of such action is earnestly solicited.

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A handwritten signature in black ink, appearing to read "Paul J. Killos", is written over a horizontal line.

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